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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,855	07/25/2003	Lauro Alvicio Volkart	024733-00010	9804

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EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,855

Applicant(s)

VOLKART, LAURO ALVICIO

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The current specification is riddled with grammatical errors such as that located on page 1, lines 13, 19-20, 22-24. These sections are difficult to read and understand exactly what point applicant is attempting to get across. The substitute specification filed must be accompanied by a statement that it contains no new matter. The substitute specification should contain section headings so that the application can be better understood and read by the observer.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 contains the phrase "of resilient and/or materials..." which renders the claim so. It is not clear what is meant to be encompassed by this limitation in the claim. With respect to claim 2, it is not clear how many absorber sets are being claimed. Is it six?? Also in claim 2, the phrase "can be arranged parallel or not" renders the claims vague and indefinite. It is not clear whether this is a requirement of the claim because of the words 'can be'. Also, the "parallel or not" renders the claim vague and indefinite because it is not clear what are the metes and bounds of the claims since these words appear to cover any orientation. Claim 3 also

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contains the words “can be” which renders the claim vague and indefinite for the same reason as stated above. Furthermore, claim 3 contains the phrases “or any other material which is adequate to the function to be exerted”, “and any other material adequate to each destination”, and “distance being regulars or irregulars”. These phrases all render the claim vague and indefinite because they make it unclear as to what are the metes and bounds of the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Horovitz 4,914,836. Horovitz '36 discloses all the limitations of the claims including the following: an absorber set of tubular elements 24 of resilient and/or materials (made of flexible, expandable, heat-sealable elastomer) arranged parallel to one another (see Figure 1) and positioned transversely in relation to the longitudinal axis of the shoe (see Figures 3-6); walls (see Figure 3, walls shown as sealed ends of tubes 26) placed laterally in the impact absorber closing each absorber in its both side extremities; absorber sets having tubular elements that have circular

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cross-section (see Figure 1); the tubular elements are of similar size, wall thickness and flexibility (see Figure 1 as well as col. 3, lines 51-60); the tubular elements are manufactured of a number of materials (elastomers); the tubular elements have air or gas within their interior (see col. 3, line 66- col. 4, line 17); the tubular elements are arranged side-by-side to one another regularly spaced (see Figure 1).

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown 4,782,603. Brown '603 discloses all the limitations of the claims including the following: an absorber set of tubular elements 50, 60 of resilient and/or materials arranged parallel to one another (see Figures 1 and 2) and positioned transversely in relation to the longitudinal axis of the shoe (see Figures 1 and 2); walls (polyurethane) placed laterally in the impact absorber closing each absorber in its both side extremities (tubes located inside molten polyurethane then PU is cooled); multiple absorber sets 50, 60 located throughout the sole of the shoe (See Figures 1 and 2); the sets arranged parallel or not to one another (see Figure 2); absorber sets having tubular elements that have circular cross-section (see Figures 1 and 3); the tubular elements are of similar size, wall thickness and flexibility (see col. 1, lines 49-53, tubes of each set are the same size as other tubes of the same set); the tubular elements are manufactured of a number of materials (see col. 2, lines 1-7); the tubular elements have air within their interior (see col. 3, lines 17-20); the tubular elements are arranged side-by-side to one another regularly spaced (see Figures 1-2 as well as col. 3, lines 3-6).

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Rudy 6,457,263. Rudy '263 discloses all the limitations of the claims including the following: an absorber set of tubular elements of resilient and/or materials (47 a in Figure 7) arranged parallel

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to one another (see Figure 7) and positioned transversely in relation to the longitudinal axis of the shoe (see Figure 7); walls (that of sole in Figure 7) placed laterally in the impact absorber closing each absorber in its both side extremities; multiple absorber sets (2 sets shown in Figure 7 at 47a) located throughout the sole of the shoe; the sets arranged parallel or not to one another (see Figure 7).

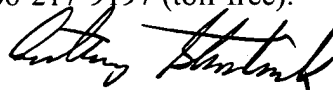
Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anthony Stashick

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Primary Examiner
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ADS